

Appl. No. 10/658,031  
Docket No. 9028  
Amdt. dated 7/14/06  
Reply to Office Action mailed on 3/17/06  
Customer No. 27752

#### REMARKS/ARGUMENTS

Claims 6-20 are cancelled without prejudice in response to a previous Restriction Requirement. Claims 2-5 are cancelled herewith, in view of the amendments to Claim 1. Claim 1 is now under consideration.

Claim 1 has been amended to include the definitional elements originally presented in Claims 2-5 and to specify that the reservoir has substantially rigid walls. Basis for this latter element is at page 8, lines 24-25. It is submitted that all amendments are fully supported and entry is requested.

#### Rejections Under 35 USC 102

Only Claims 1 and 2 stand rejected as being anticipated by U.S. 2,337,276, for reasons of record at pages 2-3 of the Office Action.

Applicants respectfully traverse the rejections, to the extent they may apply to Claim 1 as now amended.

It is noted that the elements of original Claims 2-5 have now been incorporated into Claim 1. Inasmuch as Claims 3-5 had, quite properly, not been rejected under §102, it is submitted that the incorporation of their elements into amended Claim 1 must result in that claim meeting the requirements of §102. Said another way, the new elements which now help define amended Claim 1 are not taught in '276. Withdrawal of the rejections under §102 are therefore requested.

#### Rejections Under 35 USC 103

Claims 3-5 stand rejected over '276 in view of US 5,655,686, for reasons of record at page 3 of the Office Action.

Applicants respectfully traverse the rejections, to the extent they may apply to Claim 1, as now amended to incorporate the defining elements of Claims 2-5.

At the outset, it is submitted that the cited combination of documents does not establish a *prima facie* case of obviousness of Claim 1 as now amended.

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Under MPEP 2142, the Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). If the Examiner does not prove a *prima facie* case of unpatentability, then without more, the Applicant is entitled to the grant of the patent. See in re *Oetiker*, 977 F.2d 1443.

To establish a *prima facie* case of obviousness under 35 USC §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second there must be a reasonable expectation of success. Finally, the cited references must teach or suggest all the claim limitations. See, for example, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the Office Action fails to meet all of these criteria, and thus fails to make a *prima facie* case of obviousness under 35 USC §103.

The dispensing assembly of '276 relies on the actuation of valve rod 17 which is pressed (for example) against the bottom of a glass, whereby a pre-set volume of liquid is dispensed. (Page 2, column 1, lines 29-35) No vent valve is employed (as properly noted by the Examiner). Accordingly, there would be no motivation to employ such a valve, since there is no need to control air flow into the valve assembly shown. Said another way, air flow occurs, but the configuration of the '276 dispenser does not require controlled flow.

Admittedly, '686 shows control valves. However, the '686 device functions as a result of deformation (squeezing) of a pliable container. (Abstract) Since the device of '686 is used for delivering nasal remedies without fluid draw-back into the flexible container, its mode of operation is quite different from the '276 assembly, as well as being different from the fitment herein.

In any event, Claim 1 herein has now been amended to recite the reservoir as having substantially rigid walls – i.e., the exact opposite of '686. This provides even clearer distinction over '686.

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To summarize: There is no suggestion or motivation to combine and/or to modify the cited disclosures, which, in fact, relate to assemblages quite different from the present invention, to arrive at the invention of Amended Claim 1. See *Stratoflex*, and *Vaeck*, cited above and MPEP 2145. This point was strongly underscored by the Court in reversing the Board on this same point in the *In re Anita Dembiczak and Benson Zinbarg* (Jack-O-Lantern trash bag case), 175 F.3d 994; 1999 US App. LEXIS 8109; 50 USPQ 2d (BNA) 1614. Again, the Court noted (LEXIS @ page 75):

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. [Citation omitted]

Moreover:

. . . this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the [cited references] teach or suggest their combination . . . . to yield the claimed invention. (LEXIS @ page 76)

The Board was reversed yet again on similar grounds in *In re Dow Chemical Company* 837 F.2d 469; 1988 US App LEXIS 587; 5 USPQ 2D (BNA) 1529 (LEXIS @ page 151). Citing controlling case law (LEXIS page 153), the Court said:

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be found in the prior art, not in the Applicant's disclosure. [emphasis supplied]

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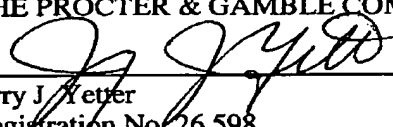
In short, it is submitted that, under the controlling case law, the cited combination of documents cannot support the rejections under §103.

In light of the foregoing, withdrawal of the rejections as they may apply to amended Claim 1 and early and favorable action in the case are requested.

Respectfully submitted,

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